

REMARKS

A Request for Continued Examination under 37 C.F.R. §1.114 and a Petition for Extension of Time under 37 C.F.R. 1.136(a) is being filed concurrently herewith.

Applicants thank the Examiner for the interview provided on November 3, 2010. During the interview, the Examiner and the Applicant's representative discussed the input provided by the Examiner and the adequacy of the declaration under C.F.R. 1.132 of record and the comparative examples provided in the present specification. While the scope of the comparative examples was discussed, no agreement was reached regarding their adequacy.

In the Office Action, claims 1-4, 8-13, and 20-26 were rejected. More specifically,

- Claim 26 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite; and
- Claims 1-4, 8-13, and 20-26 are rejected under 35 U.S.C. § 103(a) as obvious over Yoshida (JP , in view of Kouyama et al. (U.S. Patent no. 4,897,238; "Kouyama"), in further view of Krone et al. (U.S. Patent no. 4,937,032; "Krone");

By this Amendment, claim 1 has been amended and claim 26 has been canceled. Support for the amendments may be found at least at page 20, lines 13-17 and page 23, lines 7-11, as well as throughout the specification. No new matter has been added by way of amendment herein. Upon entry of this Amendment, claims 1-4 and 8-25 are pending, of which claims 14-19 are withdrawn from consideration. For the reasons set forth hereinbelow, Applicants traverse the rejections and respectfully request that the rejections of claims 1-4, 8-13, and 20-25 be withdrawn.

Claim Rejections under 35 U.S.C. § 112

Claim 26 has been cancelled, thus rendering the present rejection moot. Withdrawal is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 1-4, 8-13, and 2-26 are rejected as being obvious over Yoshida, in view of Kouyama, in further view of Krone.

The Examiner states that “Applicant argues that Yoshida teaches away from the processing conditions in Kouyama by the single example in Yoshida. The single example in Yoshida does not teach away from the processing conditions in Kouyama because there is no mention in Yoshida as to any criticality of the processing conditions used in the examples.”

However, Yoshida does not teach or suggest anything about the claimed elements of “melt-extruding the resin composition in the form of a film from a die, the lip clearance of which has been controlled to at most 1.0 mm, and then cooling and solidifying the film in a molten state at a cooling temperature in a range of 60 to 120°C” as recited in presently pending claim 1.

“A cooling mandrel controlled to 150°C±1°C by an internal cooling system” (paragraph 0013) in Example 2 where a thermoplastic polyimide was used as disclosed in Yoshida and “The internal cooling was controlled at 20°C±1°C” (paragraph 0014) in Example 3 where poly(ether ether ketone) was used indicate the technical common sense of one of ordinary skill in the art at the point of time the present application had been filed.

Accordingly, it is apparent that Yoshida does not teach the processing conditions as recited in presently amended claim 1. In addition, nothing in Kouyama or Krone cures this deficiency. Thus, in its presently amended form, Claim 1 recites limitations that are not taught or suggested by the cited references, either alone or in combination. As the Examiner is aware, to establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested in the cited references. MPEP § 2143.01. It is submitted that the

cited references do not satisfy this requirement in the claims as presently amended.

Reconsideration and withdrawal of this rejection are respectfully requested. Furthermore, it is respectfully submitted that the remaining claims are also independent for the same reason. *See* MPEP §2143.03 (stating that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious). “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, claims 2-4, 8-13, and 2-25, which depend directly from claim 1, are also nonobvious. Withdrawal of any additional rejections and allowance of the claims is respectfully requested.

Furthermore, the limitation that “at least one other thermoplastic resins, wherein all thermoplastic resins other than the poly(ether ether ketone) are present in a proportion of 0 to 5 parts by weight per 100 parts by weight of the poly(ether ether ketone)” has been introduced into present claim 1 through amendment. Applicants respectfully submit that Kouyama discloses technical matter relating only to the use of poly(arylene thioether-ketone) and does not contribute anything specifically to analysis of presently amended claim 1.

The current amendments also address the present obviousness rejections. In section 11 of the present Office Action, the Examiner indicates that “Applicant argues their cooling temperature yields unexpected results however they have failed to show the criticality at both endpoints of the range (i.e. there is no data showing that above 120 degrees the thickness uniformity would be above 1.2. In fact, some of the data point within the claimed cooling temperature range fall outside of the claimed max to min thickness ratio range: (i.e., 1-1.2 is claimed but for cooling of 90 and 110 degrees the ratio is 1.3). Applicant must amend the claims to be commensurate with the scope of the unexpected results.” In the current amendment,

the maximum value of the thickness has been amended to “1 to 1.3” times, so that the data of the Declaration in the last response and the claims has been standardized, consistent with the Examiner’s suggestion.

In addition, amendment to “at least one other thermoplastic resins, wherein all thermoplastic resins other than the poly(ether ether ketone) are present in a proportion of 0 to 5 parts by weight per 100 parts by weight of the poly(ether ether ketone)” has been made according to the Examiner’s indication. Accordingly, the presently claimed invention recites elements that “As state[d] above, properly amending the claims to reflect the aspect of the invention disclosed at page 19 and 20 of the specification would prohibit the inclusion of so much PTK as taught by Kouyama and would prevent the processing steps from being used to modify Yoshida” as indicated by the Examiner. Applicants respectfully further request withdrawal of the present obviousness rejection on this basis.

Furthermore, the claims were amended to include the language “at least one other thermoplastic resins, wherein all thermoplastic resins other than the poly(ether ether ketone) are present in a proportion of 0 to 5 parts by weight per 100 parts by weight of the poly(ether ether ketone)” in accordance with the Examiner’s suggestion. As the Examiner suggests, the present amendment will overcome the Kouyama reference and Applicants respectfully submit that the overcoming of Kouyama thus defeats the present obviousness rejection, which requires each of the three references of Yoshida, Kouyama, and Krone. Applicants request withdrawal of the present obviousness rejection additionally on this basis.

In section 13, the Examiner further states “Therefore in the next communication with the office, applicant should provide declarations showing how the lip clearance and the cooling temperature, at the particular claimed ranges, effect the final product and have unexpected

effects on the properties of the film. Applicant must also make sure that the claimed properties properly reflect the unexpected results. (i.e. contrary to the relationship between the cooling temperatures and the max/min ration in the most recent declaration as explained above).”

Applicants respectfully submit that in light the evidence of record provides adequate support for the evidence of unexpected results. First, the present amendment renders moot the Examiner’s objection to the scope of the present claims in light of the Declaration as evidence unexpected results. Specifically, comparative example four provides evidence that the constellation of claimed properties recited in claim 1 for are not present where the cooling temperature is outside of the claimed range of 60 to 120°C (e.g., 210°C). In light of the data of record, Applicants respectfully submit that the presently claimed invention displays unexpected results over the cited prior art. Reconsideration and withdrawal of the present obviousness rejection respectfully requested.

Finally, Kouyama discloses “A process for the production of a stretched poly(arylene thioether-ketone) film.” Applicants respectfully submit that Kouyama in light of that passage does not serve as a basis for rejection under obviousness of presently amended claim 1.

As described in the item III-1 (1), Yoshida does not teach anything about “melt-extruding the resin composition in the form of a film from a die, the lip clearance of which has been controlled to at most 1.0 mm, and then cooling and solidifying the film in a molten state at a cooling temperature in a range of 60 to 120°C” as recited in presently amended claim 1.

Krone discloses “A process for fabricating an integrally formed structural composite comprised of a generally flattened wall portion and at least one three-dimensional frame portion, said wall portion being derived from at least one first prepreg, and said frame portion being derived from at least one second prepreg...” (claim 1). Accordingly, Krone does not serve as

evidence for proving the obviousness of present claim 1, which includes the limitation of a semiconductive film obtained by “feeding a resin composition to an extruder.” Thus, Krone does nothing to address the deficiencies of the primary references in this regard.

CONCLUSION

Applicants respectfully request a Notice of Allowance for the pending claims under consideration in this application. If the Examiner believes that personal communication will expedite the prosecution of this application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Robert A. Muha
Registration No. 44,249

Reed Smith LLP
P.O. Box 488
Pittsburgh, PA 15230
(412) 288-7222

/James G. Dilmore/
James G. Dilmore
Reg. No. 51,618

Reed Smith LLP
P.O. Box 488
Pittsburgh, PA 15230
(412) 288-3813